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10/550,404	09/21/2005	Les Teichner	018044.01US2	2285

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NEAL, GERBER, & EISENBERG
SUITE 1700
2 NORTH LASALLE STREET
CHICAGO, IL 60602

EXAMINER

HOLLOWAY, JASON R

ART UNIT	PAPER NUMBER
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3633

NOTIFICATION DATE	DELIVERY MODE
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10/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@ngelaw.com

Office Action Summary	Application No. 10/550,404	Applicant(s) TEICHNER ET AL.	
	Examiner JASON HOLLOWAY	Art Unit 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2009 & 21 Sept 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>26 May 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species 1 in the reply filed on 26 May 2009 is acknowledged.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they still fail to show the limitations in specification page 4 lines 10-20 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

3. Further, the drawings are objected to because many of the handwritten labels are difficult to read and the drawing figures appear grainy. The examiner recommends clear drawings be submitted.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. Color photographs and color drawings are not accepted unless a petition filed under 37 CFR 1.84(a)(2) is granted (See Figure 23). Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings and black and white photographs have been satisfied. See 37 CFR 1.84(b)(2).

Specification

6. The disclosure is objected to because of the following informalities:

7. On page 7 line 12 it appears "56" should be --58--.

Appropriate correction is required.

Claim Objections

8. The claims objected to because of the following informalities:

9. In various claims, "facia" should be --fascia--.

10. In claims 26 and 36, applicant is confusing the scope of the claims with the newly added word "guard." This word appears to be just another word for the gutter

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cover. It does not appear in the original claims or specification. Since the guard is the same as the cover, the word "guard" should be omitted.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 26-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albracht (6,701,674).

Regarding claims 26 and 36, Albracht teaches a rain gutter system for buildings, comprising:

a conventional rain gutter having a generally trough-shaped interior (gutter 190 of figure 1), a rear wall extending along a roof fascia (197), a bottom wall and a front lip; and

a gutter guard (101) capable of deflecting debris from said interior of said gutter, including:

an elongate gutter cover having a back section extending along an associated roof (in figure 1 this corresponds to 107), a middle section (at 101 arrow of figure 1) extending over said interior of said gutter, and a front section extending adjacent (109) to said front lip of said gutter (as illustrated in figure 1);

said middle section of said gutter cover having an integrally formed, longitudinally extending, doubled-over fold which projects generally horizontally toward said back section of said gutter cover (the doubled over fold 112 of the embodiment of figure 8e as applied to the same feature 112 in figure 1 projects generally horizontally toward the back of the gutter cover) to define a male coupling member; and

a mounting bracket (250 of figure 1) operably connected with said gutter and having an intermediate portion (153 of figure 1) supporting said middle section of said gutter cover thereon to deflect debris from said interior of said gutter, and a forward portion (at 172) supporting said front section of said gutter cover along said front lip of said gutter;

said intermediate portion (153) of said mounting bracket having a coupling slot opening generally horizontally toward said front section of said mounting bracket (the examiner construes it would be obvious when using the embodiment of figure 8e to have a coupling slot in the mounting bracket which opens generally horizontally toward the front section to match that of the projection 112) to define a female coupling member in which said male coupling member of said gutter cover is closely received and retained to securely mount said gutter cover on said mounting bracket without separate fasteners (as illustrated in figure 1, 112 is retained in a female coupling member).

Regarding claims 27 and 37, Albracht teaches the coupling slot in said mounting bracket is generally U-shaped (153 as illustrated in figure 1 is U-shaped) with generally parallel opposite sidewalls (figure 1 shows parallel sidewalls) inclined in a

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downward direction (the examiner construes the coupling slot is slightly inclined downwardly due to the shape of the inclination of the gutter cover 101).

Regarding claims 28 and 38, Albracht teaches the fold in said gutter cover is spaced below and parallel with said middle section of said gutter cover, and is inclined in an upward direction (projection 112 as illustrated in figure 8e).

Regarding claim 29 and 39, Albracht teaches the male coupling member (112 of figure 8e) on said gutter cover is shaped for secure, yet detachable, reception in said female coupling member on said mounting bracket (the connection illustrated in figure 1 as applied to the embodiment of figure 8e meets these claim limitations).

Regarding claim 30 and 40, Albracht teaches at least one gutter hanger (clip 179 of figure 1) supporting said gutter along the fascia board of the associated roof, and including at least one generally vertically oriented mounting aperture therethrough (where 159 of the bracket connects to the hanger); and

wherein said mounting bracket includes at least one fastener (at 159 of figure 1) received and retained in said mounting aperture of said gutter hanger (179) to support said mounting bracket on said gutter hanger.

However, Albracht fails to explicitly disclose the fastener is pin shaped. It would have been obvious to one of ordinary skill in the art to make the fastener pin shaped instead since a change in the design of the connection between the hanger and bracket would have required only minimal skill in the art. The connection at 159 of figure 1 is a functional equivalent of a pin shaped fastener and thus meets the structural limitations of the claim.

Regarding claims 31 and 41, Albracht teaches the fastener comprises a push-in fastener (the examiner construes the connection between foot 159 and hanger 179 is a snap fit connection wherein the foot 159 would have to be pushed into place, thus meeting the claim limitations. The obviousness of a pin shaped fastener is addressed in the rejection to claim 30.

Regarding claims 32 and 42, Albracht teaches the front section of said gutter cover has an arcuately shaped lip section (section 116 of the gutter cover is an arc) shaped; and

said forward portion of said mounting bracket has a shaped forward most area shaped similar to and abutting said lip section of said gutter cover (as illustrated in figure 1). The examiner notes the front of the bracket is not quite shaped like an arc, however it would have been obvious to one of ordinary skill in the art to make the simple design change to have an arc shaped bracket to correspond to the arc of the gutter cover.

Regarding claims 33 and 43, Albracht teaches the gutter cover includes at least one protrusion shaped in a way capable of impeding rainwater flow into said interior of said gutter (the projection 112' of figure 1 is capable of impeding rainwater flow into the gutter, thus meeting this claim limitation).

Regarding claims 34 and 44, Albracht teaches the mounting bracket includes a center wall portion (leg bridge 154 can be considered a center wall, along with the left side of 153 of figure 1).

Regarding claims 35 and 45, Albracht teaches the mounting bracket has a one-piece, integrally formed, molded construction (as illustrated in figure 1) of synthetic resin material (column 5 lines 65-67 teach the bracket can be made from metal, plastic, fiberglass or vinyl). The examiner would like to further point out that it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make the bracket from a synthetic resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material.

Response to Arguments

Applicant's arguments with respect to claims 26-45 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON HOLLOWAY whose telephone number is (571) 270-5786. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JASON HOLLOWAY
Examiner
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/Brian E. Glessner/
Primary Examiner, Art Unit 3633